

1. The amendment of 1/21/10 has been entered. Claims 26-36, 38-45, 47-57, and 60-112 are pending.

2. Newly submitted claims 57 and 60-112 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

A. Restriction to one of the following inventions would have been required under 35 U.S.C. 121:

I. Claims 26-36, 38-45, and 47-56, originally presented and examined, drawn to a polyurethane dispersion and method of making, classified in class 524, subclass 591 among others.

II. Newly presented claims 57 and 60-112, drawn to a method of sealing a building material, classified in class 427, subclass 372.2 among others.

B. The inventions are independent or distinct, each from the other because:

i. Inventions of group I, particularly the composition claims thereof, and newly presented group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the composition has a different method of use from each of those of groups II and III as shown by the independent and distinct uses of groups III and II respectively. Furthermore, the composition of group I can be used to make a free standing film or three dimensional molded articles.

ii. Inventions of group I, particularly the methods of making the compositions of group I, and newly presented group II are directed to related distinct processes. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed an have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. The invention of group I makes a composition and does not require the steps of groups II or III, which result in coated substrates or adhered materials, which are different effects, designs, modes of operation, and functions. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

C. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 57 and 60-112 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

See also MPEP 706.07(h), particularly “Applicants cannot file an RCE to obtain
continued

examination on the basis of claims that are independent and distinct from the claims previously claimed and examined as a matter of right (i.e., applicant cannot switch inventions). See 37 CFR 1.145. Any newly submitted claims that are directed to an invention that is independent and distinct from the invention previously claimed will be withdrawn from consideration and not entered.”

The applicant’s argument that there would have been no undue burden to further examine the newly presented distinct inventions is without basis. The examiner has only 16.26 hours to examine the entirety of the instant application. It is impossible to examine all of the presented inventions in that time particularly when there is presented after initial examination a new, distinct invention. Allowing the change of inventions to different distinct inventions makes it

impossible to achieve compact prosecution. The examiner believes that is why the above restrictions against adding distinct inventions after initial examination and in RCEs exist. These impossibilities are undue burdens. The applicant does not address the above cited sections of the MPEP regarding claiming distinct inventions after initial examination and in the presentation of RCEs. The restriction is maintained therefore.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 26-36, 38-45, and 47-56 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 6462127 Ingrisch et al..

Ingrisch discloses the instantly claimed polyurethane dispersions at the abstract; column 1, lines 4-67; column 2, lines 1-67; column 3, lines 1-67, particularly 44-67 which broadly encompasses the instantly claimed invention; column 4, lines 1-67, particularly 18-67, which encompasses the instantly claimed ingredients and amounts thereof. It is noted that the instant claim recites ">12" regarding component A and the disclosure's preferred amount of the instantly claimed component A is 0.3-12%. However, the amount of the patentee is based on the amount of their component H. Before addition of the patentee's component H, the patentee's

component A is present in a greater amount than when H is added, e.g. consider the patentee's 12% of A which gives $12/(88 \text{ of all components but A} + 12 \text{ of A})$ and removal of the lower amount of H of the patentee, i.e. 5% which gives $12/((88-5) + 12)$ which is about 12.6% of A. Removing larger amounts of the patentee's H and using 12% of the instantly claimed A in the patentee's compositions clearly gives even larger amounts of A in the patentee's compositions, which meets the instant claims using more than 12% of the instantly claimed component A.

Furthermore, the patentee's preferred amount of 0.3-12% overlaps with the instantly claimed ">12" regarding component A because the mathematical precision of each claimed number is such that they read only on the values that round off to "12". Thus, the instant claims are taken to include e.g. 11.9 while the patentee's disclosure is taken to include e.g. 12.1, within mathematical principles. Furthermore, one cannot measure the claimed amounts to within a single molecule of the claimed material. Thus, the claimed values overlap within experimental error for this reason. The preferred nature of the patentee's upper limit of 12 is taken as disclosing the portion of the patentee that overlaps with the instant claims for the reasons stated above so as to constitute being disclosed with sufficient specificity so as to anticipate the instantly claimed amount of component A.

Thus, the intermediate of the patentee prior to addition of their component H has the instantly claimed amount of A. The ingredients of column 5, lines 1-8 are additional to those of the instant claims. Taking the amounts of column 5, lines 1-8 of the patentee from the patentee's composition and using the larger amounts of the instantly claimed component A of the patentee gives amounts within those of the instant claims since removing the amounts of column 5, lines 1-8 lowers the amount of the denominator used to calculate the amounts. Furthermore, the

amounts overlap due to experimental error in making such measurements and because the broader disclosure of the patentee encompasses larger than the preferred amounts of the instantly claimed component A. Note also column 5, lines 9-67; column 6, lines 1-67, column 7, lines 1-67; column 8, lines 1-67; column 9, lines 1-67; column 10, lines 1-19, which encompasses the instantly claimed high molecular weight; column 11, lines 18-67; column 12, lines 1-67, particularly the method steps and temperatures which fall within the scope of those of the instant method claims; column 13, lines 1-44 which discloses the instantly claimed substrates; and the remainder of the document which encompasses the limitations of the remaining claims, particularly the examples and the claims.

The instant claims 38 and 47-49 recite “comprising” and therefore include the addition of other ingredients due to the open nature of the claims. The instant claims which continue to recite open language continue to encompass the additional components of the patentee. Column 11, lines 31-48, particularly 44-48 show that the polyurethane dispersion not containing H and I of the patentee is prepared and exists for a finite period of time without the presence of H and I of the patentee. This existence, albeit for a limited time, meets the requirements of the instant claims 26 and 52 in that the intermediate does not contain anything excluded by the recitations of “consisting” of the instant claims. Nothing in the caselaw is seen that would prevent the applicant from adding H and I of Ingrisich to their compositions at some later time. Ingrisich does not exemplify the instantly claimed inventions.

The applicant’s arguments ignore the fact that the intermediate composition of the patentee consisting of only the instantly claimed reactants clearly exists for a finite period of time and that existence meets the instantly claimed requirements. Note particularly column 11, lines 44-48,

particularly "and then" of line 47, which clearly indicates the existence for a finite period of time of the instantly claimed composition consisting of the instantly claimed components/reactants. That the amounts of the instant claims are met by the cited prior art is discussed above. The above points are not rebutted by the applicant. There are no additional components required of the intermediate of the patentee, e.g. that of column 11, lines 31-48 prior to performing reaction stage (b), which is the subject of the instant rejection, that are excluded by the instant claims.

The instant claim 50 continues to recite "comprising" such that the additional components of the patentee are encompassed by the instant claim 50, though the instantly claimed amounts are met, when based on the instantly claimed components only, as discussed above.

The applicant's arguments have been fully considered but are not persuasive for the reasons stated above. The rejection is maintained for the above reasons.

6. Claims 26-36, 38-45, and 47-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6462127 Ingrisch et al..

Ingrisch discloses the instantly claimed polyurethane dispersions at the abstract; column 1, lines 4-67; column 2, lines 1-67; column 3, lines 1-67, particularly 44-67 which broadly encompasses the instantly claimed invention; column 4, lines 1-67, particularly 18-67, which encompasses the instantly claimed ingredients and amounts thereof. It is noted that the instant claim recites ">12" regarding component A and the disclosure's preferred amount of the instantly claimed component A is 0.3-12%. However, the amount of the patentee is based on the amount of their component H. Before addition of the patentee's component H, the patentee's component A is present in a greater amount than when H is added, e.g. consider the patentee's 12% of A which gives $12/(88 \text{ of all components but A} + 12 \text{ of A})$ and removal of the lower

amount of H of the patentee, i.e. 5% which gives $12/((88-5) + 12)$ which is about 12.6% of A. Removing larger amounts of the patentee's H and using 12% of the instantly claimed A in the patentee's compositions clearly gives even larger amounts of A in the patentee's compositions, which meets the instant claims using more than 12% of the instantly claimed component A.

Furthermore, the patentee's preferred amount of 0.3-12% overlaps with the instantly claimed ">12" regarding component A because the mathematical precision of each claimed number is such that they read only on the values that round off to "12". Thus, the instant claims are taken to include e.g. 11.9 while the patentee's disclosure is taken to include e.g. 12.1, within mathematical principles. Furthermore, one cannot measure the claimed amounts to within a single molecule of the claimed material. Thus, the claimed values overlap within experimental error for this reason. The preferred nature of the patentee's upper limit of 12 is taken as disclosing the portion of the patentee that overlaps with the instant claims for the reasons stated above so as to constitute being disclosed with sufficient specificity so as to anticipate the instantly claimed amount of component A.

Thus, the intermediate of the patentee prior to addition of their component H has the instantly claimed amount of A. The ingredients of column 5, lines 1-8 are additional to those of the instant claims. Taking the amounts of column 5, lines 1-8 of the patentee from the patentee's composition and using the larger amounts of the instantly claimed component A of the patentee gives amounts within those of the instant claims since removing the amounts of column 5, lines 1-8 lowers the amount of the denominator used to calculate the amounts. Furthermore, the amounts overlap due to experimental error in making such measurements and because the broader disclosure of the patentee encompasses larger than the preferred amounts of the instantly

claimed component A. Note also column 5, lines 9-67; column 6, lines 1-67, column 7, lines 1-67; column 8, lines 1-67; column 9, lines 1-67; column 10, lines 1-19, which encompasses the instantly claimed high molecular weight; column 11, lines 18-67; column 12, lines 1-67, particularly the method steps and temperatures which fall within the scope of those of the instant method claims; column 13, lines 1-44 which discloses the instantly claimed substrates; and the remainder of the document which encompasses the limitations of the remaining claims, particularly the examples and the claims.

The instant claims 38 and 47-49 recite "comprising" and therefore include the addition of other ingredients due to the open nature of the claims. The instant claims which continue to recite open language continue to encompass the additional components of the patentee. Column 11, lines 31-48, particularly 44-48 show that the polyurethane dispersion not containing H and I of the patentee is prepared and exists for a finite period of time without the presence of H and I of the patentee. This existence, albeit for a limited time, meets the requirements of the instant claims 26 and 52 in that the intermediate does not contain anything excluded by the recitations of "consisting" of the instant claims. Nothing in the caselaw is seen that would prevent the applicant from adding H and I of Ingrisich to their compositions at some later time.

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It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the ingredients and amounts thereof and the reaction parameters of the instant claims in making the dispersions of the patentee because these are encompassed by the disclosure of the patentee and would have been expected to give the

properties of the dispersions of the patentee. It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed amounts of the instantly claimed component A in the dispersions of the patentee because using one % more than the upper level of the preferred amounts of the patentee that read on the amounts of the instant claims will not give a significantly different result and will give only predictable results to the ordinary skilled artisan, i.e. 12% to 13% is not expected to give much difference and is encompassed by the broad disclosure of the patentee as preferred mode does not teach away from other values and the broad disclosure encompasses broader values of the amount of A. The applicant's arguments have been fully considered but are not persuasive for the reasons stated above and the teachings of the patentee.

The applicant's arguments ignore the fact that the intermediate composition of the patentee consisting of only the instantly claimed reactants clearly exists for a finite period of time and that existence meets the instantly claimed requirements. Note particularly column 11, lines 44-48, particularly "and then" of line 47, which clearly indicates the existence for a finite period of time of the instantly claimed composition consisting of the instantly claimed components/reactants. That the amounts of the instant claims are met by the cited prior art is discussed above. The above points are not rebutted by the applicant. There are no additional components required of the intermediate of the patentee, e.g. that of column 11, lines 31-48 prior to performing reaction stage (b), which is the subject of the instant rejection, that are excluded by the instant claims.

The instant claim 50 continues to recite "comprising" such that the additional components of the patentee are encompassed by the instant claim 50, though the instantly claimed amounts are met, when based on the instantly claimed components only, as discussed above.

There is no showing of unexpected results stemming from the instantly claimed invention over the prior art, discussed above, which is commensurate in scope with the instant claims and the cited prior art. The applicant's arguments regarding "improved properties" ignores the above rejection, particularly column 11, lines 31-48, prior to reaction stage (b) of the patentee.

The applicant's arguments have been fully considered but are not persuasive for the reasons stated above. The rejection is maintained for the above reasons.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Friday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/
Primary Examiner
Art Unit 1796